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HEWLETT PACKARD COMPANY

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INTELLECTUAL PROPERTY ADMINISTRATION

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EXAMINER

THEIN, MARIA TERESA T

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/665,349
Filing Date: September 18, 2000
Appellant(s): HARPER ET AL.

MAILED

OCT 03 2007

GROUP 3600

Jim Shaurette
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 5, 2006 appealing from the Office action mailed June 1, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

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Claims 1, 4, 6, 8, 11-12, 14-15, 17, 19, 22, 23, and 24-33 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,016,409 to Beard et al.

Claims 2-3, 7, 9, 10, 16, and 20 stand rejected under 35 U.S.C. § 103 (a) as allegedly being obvious over U.S. Patent No. 6,016,409 to Beard et al. in view of U.S. Patent No. 5,884,073 to Dent.

Claim 5 stands rejected under 35 U.S.C. § 103 (a) as allegedly being obvious over U.S. Patent No. 6,016,409 to Beard et al. in view of U.S. Patent No. 6,041,360 to Himmet et al.

Claim 13 and 18 stand rejected under 35 U.S.C. § 103 (a) as allegedly being obvious over U.S. Patent No. 6,016,409 to Beard et al. in view of U.S. Patent No. 6,247,044 to Gosling.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,016,049	Beard et al.	1-2000
5,884,073	Dent	3-1999
6,041,360	Himmel et al.	3-2000
6,247,044	Gosling et al.	6-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 6, 8, 11-12, 14-15, 17, 19, 22, 23, and 24-33 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,016,409 to Beard et al.

Regarding claim 1, Beard discloses a method of programming a non-volatile memory unit (col. 7, lines 38-40) in a hard copy output engine comprising: determining a geographical area within which the hard copy output engine is to be deployed (This is another code, placed by the manufacturer in a predetermined address in the CRUM memory which identifies the module as belonging to a particular market region, such as a geographical region....Thus, within an initialization procedure, the distribution board 30 reads a code describing a market region stored in the CRUM memory for a confirmation, col. 8, lines 44-56); determining an address for a consumable supplier (supplier or service organization) appropriate to the geographical area (col. 8, lines 29-34; col. 9, lines 6-9; col. 11, lines 26-32); and programming the electronic address into the non-volatile memory (col. 8, lines 13-17; col. 8, lines 24-34; col. 10, lines 57-65).

The Examiner notes that every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's address. Therefore, it is inherent that Beard provides an electronic address for the supplier or service organization in order to communicate directly to the supplier or service organization from the distribution board 30 through the network.

Regarding claims 4 and 6, Beard discloses programming the non-volatile memory with product descriptors for consumable supplies associated with the hard copy output engine (col. 12, lines 51-67); and the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers, and printers (col. 5, lines 15-19).

Regarding claim 8, Beard discloses determining that an amount of consumable for the hard copy output engine is less than a threshold amount (col. 12, lines 8-23); extracting an electronic address for a vendor of the consumable from a non-volatile memory included in the hard copy output engine (col. 12, lines 23-28); and initiating communication with the vendor (service organization) using the electronic address; and communicating with the vendor from the hard copy output engine (col. 12, lines 23-28).

Regarding claims 11, 12 and 14, Beard discloses the communicating includes transmitting an electronic message from the hard copy output engine which orders a predetermined quantity of the consumable determined to be present in an amount less

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than the threshold amount (col. 12, lines 8-23; col. 10, lines 35-65); determining using processing circuitry in response to a sensor in the hard copy output engine sensing that an amount of the consumable is less than a threshold amount (col. 7, line 33-col. 8, line 2; col. 12, lines 8-23); and the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (col. 5, lines 15-19).

Regarding claim 15, Beard discloses a computer implemented control system for a hard copy output engine, the system comprising: non-volatile memory (CRUM) included in the hard copy output engine and configured to store data representing an electronic address for a supplier of consumables for the hard copy output engine (col. 7, lines 5-14; col. 8, lines 13-17; col. 8, lines 29-34); and processing circuitry (col. 7, line 33-col. 8, line 2) configured to: determine that an amount of a consumable for the hard copy output engine is less than a threshold amount (col. 12, lines 8-23); extract the electronic address from the non-volatile memory (col. 12, lines 23-28); and communicate with the supplier using the electronic address (col. 12, lines 23-28).

The Examiner notes that every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's address. Therefore, it is inherent that Beard provides an electronic address for the

supplier or service organization in order to communicate directly to the supplier or service organization from the distribution board 30 through the network.

Regarding claims 17, 19, and 22, Beard discloses wherein the processor configures to communicate includes a processor configured to transmit an electronic message ordering a predetermined quantity of the consumable determined to be present in an amount less than the threshold amount (col. 10, lines 35-65; col. 12, lines 8-23); the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (col. 5, lines 15-19); and wherein the processing circuitry is included in the hard copy output engine (col. 7, line 33-col. 8, line 2).

Regarding claim 23, Beard discloses a method of obtaining consumable suppliers for a hard copy output engine, comprising: determining a geographical area within which the hard copy output engine is to be deployed (This is another code, placed by the manufacturer in a predetermined address in the CRUM memory which identifies the module as belonging to a particular market region, such as a geographical region....Thus, within an initialization procedure, the distribution board 30 reads a code describing a market region stored in the CRUM memory for a confirmation, col. 8, lines 44-56); determining an electronic address for a consumables supplier appropriate to the geographical area (col. 8, lines 29-34; col. 9, lines 6-9; col. 11, lines 26-32); storing the electronic address in a non-volatile memory of the hard copy output engine (col. 8, lines 13-17; col. 8, lines 24-34; col. 10, lines 57-65); and proactively initiating communication with the consumables supplier from the hard copy output engine using the stored electronic address responsive to an amount of a consumable for the hard copy output

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engine being less than a predetermined threshold (col. 10, lines 35-65; col. 12, lines 8-23).

The Examiner notes that every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's address. Therefore, it is inherent that Beard provides an electronic address for the supplier or service organization in order to communicate directly to the supplier or service organization from the distribution board 30 through the network.

Regarding claims 24-25, Beard discloses wherein the determinings and the programming are performed prior to deployment of the hard copy output engine in an end user environment (col. 8, lines 24-28; col. 13, lines 39-41; col. 12, lines 51-56); and wherein the programming comprises programming into the non-volatile memory resident within the hard copy output engine (col. 7, lines 5-8; col. 7, lines 23-47; col. 8, lines 7-13).

Regarding claim 26, Beard discloses determining the electronic address corresponding to a geographical area in which the hard copy output engine will be deployed in an end user environment (This is another code, placed by the manufacturer in a predetermined address in the CRUM memory which identifies the module as belonging to a particular market region, such as a geographical region....Thus, within an

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initialization procedure, the distribution board 30 reads a code describing a market region stored in the CRUM memory for a confirmation, col. 8, lines 44-56; col. 8, lines 29-34; col. 9, lines 6-9; col. 11, lines 26-32); and storing the electronic address within the hard copy output engine prior to deployment of the hard copy output engine (col. 8, lines 13-17; col. 8, lines 24-34; col. 10, lines 57-65).

Regarding claim 27, Beard discloses wherein the non-volatile memory is configured to store the data representing the electronic address prior to deployment of the hard copy output engine in an end user environment (col. 8, lines 24-28; col. 8, lines 44-56; col. 13, lines 39-41; col. 12, lines 51-56).

Regarding claim 28, Beard wherein the determining and the storing are performed prior to deployment of the hard copy output engine in an end user environment (col. 8, lines 24-28; col. 13, lines 39-41; col. 12, lines 51-56).

Regarding claim 29, Beard discloses wherein the communicating comprises directly sending an electronic message from the hard copy output engine to the vendor without user intervention (col. 8, lines 29-34; col. 9, lines 5-10, col. 10, lines 35-65).

Regarding claim 30, Beard discloses wherein the processing circuitry comprises processing circuitry of the hard copy output engine configured to communicate an electronic message from the hard copy output engine to the supplier without user intervention (col. 8, lines 29-34; col. 9, lines 5-10, col. 10, lines 35-65).

Regarding claim 31, Beard discloses wherein the processing circuitry comprises processing circuitry of the hard copy output engine configured to communicate an

electronic message directly to the supplier (col. 8, lines 29-34; col. 9, lines 5-10, col. 10, lines 35-65).

Regarding claim 32, Beard discloses wherein the proactively initiating communication comprises sending an electronic message from the hard copy output engine to the supplier without user intervention (col. 8, lines 29-34; col. 9, lines 5-10, col. 10, lines 35-65).

Regarding claim 33, Beard discloses wherein the proactively initiating communication comprises directly communicating with the supplier using the hard copy output engine (col. 8, lines 29-34; col. 9, lines 5-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 7, 9, 10, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,016,409 to Beard in view of U.S. Patent No. 5,884,073 to Dent. Beard substantially discloses the claimed invention, however, it does not disclose the universal resource locator. Beard discloses orders for new toner bottles are made directly by distribution board 30 over a network to the service organization (col. 12, lines 23-25).

Dent, on the other hand, teaches a system and method for enhancing manageability of an electronic system (col. 3, lines 3-5). The electronic system enables

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remote system-level diagnostics through a privately or publicly accessible network in the event of a failure or malfunction (col. 3, lines 5-7). The electronic system may include hard copy equipment (col. 3, lines 9-11). Dent further discloses a non-volatile memory within the electronic system that contains a web address for the service provider and a web browser application program (col. 4, lines 16-19). The web address is the universal resource locator.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and system of Beard, to include the Universal resource locator, as taught by Dent, in order to establish communications with a remotely located service provider via a network (Dent col. 2, lines 40-41).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,016,409 to Beard in view of U.S. Patent No. 6,041,360 to Himmel et al.

Beard substantially disclose the claimed invention, however, it does not disclose the determining the electronic address is obsolete; determining a revised electronic address; and reprogramming the non-volatile memory with the revised electronic address. Beard discloses a CRUM which hare associated with one or more customer-replaceable modules within the apparatus (col. 7, lines 5-8). THE CRUM is in the form of a 2K bit serial EEPROM and is connected to the distribution board 30 using a two-wire serial bus architecture (col. 7, lines 33-38). A non-volatile memory within the CRUM is designed for special applications requiring data storage (col. 7, lines 38-40). Different types of data can be stored in a CRUM, which is read or updated by the distribution board 30 (col. 8, lines 7-9).

Himmel, on the other hand, teaches determining the electronic address (URL) is obsolete (change in web page data can be detected during a request for the web page by the first bookmark; col. 3, lines 5-6); determining a revised electronic address (if redirection of the request to a new URL is detected, the first bookmark is updated to the new URL; col. 3, lines 7-8); and reprogramming the memory with the revised electronic address (col. 2, line 63 – col. 3, line 23; col. 4, lines 31-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Beard, to include the determining of the electronic address is obsolete; determining a revised electronic address; and reprogramming, as taught by Himmel, in order to provide updated bookmarks (collection of URLs) in an easy and automatic way (Himmel col. 13, lines 40-41).

Claims 13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,016,409 to Beard in view of U.S. Patent No. 6,247,044 to Gosling et al. Beard substantially discloses the claimed invention, however, it does not disclose the servlet. Beard discloses sending a request through a network (col. 8, lines 31-32).

Gosling, on the other hand, teaches a determination whether the request required dynamically generated information from a servlet of the client-server network (col. 2, lines 664-67). A servlet corresponding to the request which may be uploaded from a remote server computer (col. 1, line 67 - col. 2, line 2) of the client-server

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network. The servlet is then executed to obtain generated information corresponding to the request (col. 2, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and system of Beard, to include the servlet, in order to provides an environment that is flexible and extendible (Gosling col. 1, lines 55-57).

(10) Response to Argument

Preliminary Note: The Examiner has adopted the Appellants' outline format for use in addressing Appellants' arguments.

A. Limitations of claims 1-7, 23-25, 28, and 32-33 are not disclosed nor suggested by Beard and the anticipation rejection is in error.

Appellants argue that the limitation "determining an electronic address for a consumable supplier or vendor appropriate to a geographical are in which the hard output engine is to be deployed" is not disclosed nor suggested by the prior art and the anticipation rejection is improper. Appellants further argue that "the identified teachings fail to disclose or suggest an teaching "regarding an electronic address or the determination of the electronic address....".

The Examiner does not agree. Beard does disclose "determining an electronic address for a consumable supplier or vendor appropriate to a geographical are in which the hard output engine is to be deployed" and "regarding an electronic address or the determination of the electronic address....". Beard discloses a printing apparatus

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comprising a distribution board, which can send or receive messages through the network (col. 6, lines 62-67). The distribution board interacts and is connected with memory devices called CRUMs (customer replace unit monitors), which are associated with one or more customer-replaceable modules within the apparatus and retain information for the particular module about how that module is being used within a machine (col. 7, lines 5-8; col. 7, lines 24-26; col. 7, lines 36-38). The CRUM is a small notepad on which certain key data is entered and retained and also periodically updated (col. 7, lines 26-28). The CRUM includes a non-volatile memory, which is designed for special applications requiring data storage in a ROM, PROM, and EEPROM mode (col. 7, lines 38-40). The CRUM serves as both a transmitter and receiver in the synchronous transfer of data with distribution board (col. 7, lines 44-46). Information such as codes is stored in the CRUM memory (col. 8, lines 14-15). The information includes a type of service plan code and market region code. One type of service plan code is a lease arrangement which it becomes the responsibility of the manufacturer or service organization to replace modules well in advance of any end-of-life of the module (col. 8, lines 20-24). The lease arrangement, which is symbolized by a particular service plan code in the CRUM, could instruct the distribution board to send a request to re-order new modules through the network to the manufacturer or service organization (col. 8, lines 29-34). Beard also discloses a market region code, which is placed by the manufacturer in a predetermined address in the CRUM memory, that identifies the module as belonging to a particular market region, such as a geographical region (col. 8, lines 44-47).

The Examiner notes that every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's address. In Beard, an electronic address must be used to send a request to re-order new modules through the network, in order to communicate with the manufacturer or service organization (col. 8, lines 29-34).

Such CRUM having certain key data which is entered and retained and also periodically updated; CRUM serving as both a transmitter and receiver in the synchronous transfer of data with distribution board; distribution board interacting and is connected to the CRUMs; information being stored in the CRUM memory; a particular service plan code in the CRUM, instructing the distribution board to send a request to re-order new modules through the network to the manufacturer or service organization; and the market region code, which is placed by the manufacturer in a predetermined address in the CRUM memory, that identifies the module as belonging to a particular market region, such as a geographical region are considered "determining an electronic address for a consumable supplier or vendor appropriate to a geographical area in which the hard output engine is to be deployed" and "regarding an electronic address or the determination of the electronic address....".

Appellants argues "that the Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teaching of the applied prior art". "Appellant respectfully submits some arrangements may be used which do not utilize electronic addresses programmed or stored in memory. For example, Appellant has submitted a dictionary definition of token, token ring network wherein tokens are used to pass communication between computers which hare void of mentioning use of electronic addresses."

As discussed above, every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. Furthermore, Examiner has provided a definition of token and token ring network from "Newton's Telecom Dictionary" (1998), which includes the use of addresses. The dictionary defines token as "in networking, a unique combination of bits used to confer transmit privileges to a computer on a local area network. It also carries important information for routing messages over the network, such as source and destination addresses, etc. When a LAN-attached computer receives a token, it has been given permission to transmit. On a token ring network, the token is 24 bits long". Furthermore, the dictionary further defines a token ring packet as "packets on a token ring network are made up of nine fields: starting delimiter, access control, frame control, destination address, source, address, routing

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information, the data, frame check sequence, and ending delimiter.... Destination Address is a 48 bit sequence that uniquely identifies the physical name of the computer to which the data packet is being transmitted.... Source Address is a 48 bit sequence that uniquely identifies the physical name of the computer that send the packet data”.

B. Limitation of claims 1-7, 23-25, 28, and 32-33 are not disclosed nor suggested by Beard and the anticipation rejection is in error.

Appellants argue that the limitation “programming or storing an electronic address for a consumables supplier or vendor appropriate to a geographical area in which the hard copy output engine is to be deployed in memory of the hard copy output engine” is not disclosed nor suggested by the prior art and the anticipate rejection.

The Examiner does not agree. Beard does disclose “programming or storing an electronic address for a consumables supplier or vendor appropriate to a geographical area in which the hard copy output engine is to be deployed in memory of the hard copy output engine”. Beard discloses a printing apparatus comprising a distribution board, which can send or receive messages through the network (col. 6, lines 62-67). The distribution board interacts and is connected with memory devices called CRUMs (customer replace unit monitors), which are associated with one or more customer-replaceable modules within the apparatus and retain information for the particular module about how that module is being used within a machine (col. 7, lines 5-8; col. 7, lines 24-26; col. 7, lines 36-38). The CRUM is a small notepad on which certain key data is entered and retained and also periodically updated (col. 7, lines 26-28). The

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CRUM includes a non-volatile memory, which is designed for special applications requiring data storage in a ROM, PROM, and EEPROM mode (col. 7, lines 38-40). The CRUM serves as both a transmitter and receiver in the synchronous transfer of data with distribution board (col. 7, lines 44-46). Information such as codes is stored in the CRUM memory (col. 8, lines 14-15). The information includes a type of service plan code and market region code. One type of service plan code is a lease arrangement which it becomes the responsibility of the manufacturer or service organization to replace modules well in advance of any end-of-life of the module (col. 8, lines 20-24). The lease arrangement, which is symbolized by a particular service plan code in the CRUM, could instruct the distribution board to send a request to re-order new modules through the network to the manufacturer or service organization (col. 8, lines 29-34). Beard also discloses a market region code, which is placed by the manufacturer in a predetermined address in the CRUM memory, that identifies the module as belonging to a particular market region, such as a geographical region (col. 8, lines 44-47).

The Examiner notes that every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's address. In Beard, an electronic address must be used to send a request to re-order

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new modules through the network, in order to communicate with the manufacturer or service organization (col. 8, lines 29-34).

Such CRUM having certain key data which is entered and retained and also periodically updated; CRUM serving as both a transmitter and receiver in the synchronous transfer of data with distribution board; distribution board interacting and is connected to the CRUMs; information being stored in the CRUM memory; a particular service plan code in the CRUM, instructing the distribution board to send a request to re-order new modules through the network to the manufacturer or service organization; and the market region code, which is placed by the manufacturer in a predetermined address in the CRUM memory, that identifies the module as belonging to a particular market region, such as a geographical region are considered are considered “programming or storing an electronic address for a consumables supplier or vendor appropriate to a geographical area in which the hard copy output engine is to be deployed in memory of the hard copy output engine”.

Appellants argue that “it is not inherent from the teachings of Beard to program or store an electronic address using memory”

As discussed above, every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. In Beard, an electronic address must

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be used to send a request to re-order new modules through the network, in order to communicate with the manufacturer or service organization (col. 8, lines 29-34).

C. Limitations of claims 8-14, 15-20, 22, 26-27, 29, and 30-31 are not disclosed nor suggested by Beard and the anticipation rejection is in error.

Appellants argue that Beard does not disclose nor suggest "extracting an electronic address for a vendor or supplier of a consumable from memory included in a hard copy output engine in combinations with initiating and directly communication with a vendor using the electronic address or communicating with a supplier of consumable using the electronic address".

The Examiner does not agree. Beard does disclose "extracting an electronic address for a vendor or supplier of a consumable from memory included in a hard copy output engine in combinations with initiating and directly communication with a vendor using the electronic address or communicating with a supplier of consumable using the electronic address". Beard discloses a printing apparatus comprising a distribution board, which can send or receive messages through the network (col. 6, lines 62-67). The distribution board interacts and is connected with memory devices called CRUMs (customer replace unit monitors), which are associated with one or more customer-replaceable modules within the apparatus and retain information for the particular module about how that module is being used within a machine (col. 7, lines 5-8; col. 7, lines 24-26; col. 7, lines 36-38). The CRUM is a small notepad on which certain key data is entered and retained and also periodically updated (col. 7, lines 26-28). The

CRUM includes a non-volatile memory which is designed for special applications requiring data storage in a ROM, PROM, EEPROM mode (col. 7, lines 38-40). The CRUM serves as both a transmitter and receiver in the synchronous transfer of data with distribution board (col. 7, lines 44-46). Information such as codes is stored in the CRUM memory (col. 8, lines 14-15). The information includes a type of service plan code and market region code. One type of service plan code is a lease arrangement which it becomes the responsibility of the manufacturer or service organization to replace modules well in advance of any end-of-life of the module (col. 8, lines 20-24). The lease arrangement, which is symbolized by a particular service plan code in the CRUM, could instruct the distribution board to send a request to re-order new modules through the network to the manufacturer or service organization (col. 8, lines 29-34). Beard also discloses a market region code, which is placed by the manufacturer in a predetermined address in the CRUM memory, that identifies the module as belonging to a particular market region, such as a geographical region (col. 8, lines 44-47).

The Examiner notes that every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's address. In Beard, an electronic address must be used to send a request to re-order

new modules through the network, in order to communicate with the manufacturer or service organization (col. 8, lines 29-34).

Such CRUM having certain key data which is entered and retained and also periodically updated; CRUM serving as both a transmitter and receiver in the synchronous transfer of data with distribution board; distribution board interacting and is connected to the CRUMs; information being stored in the CRUM memory; and a particular service plan code in the CRUM, instructing the distribution board to send a request to re-order new modules through the network to the manufacturer or service organization are considered are "extracting an electronic address for a vendor or supplier of a consumable from memory included in a hard copy output engine in combinations with initiating and directly communication with a vendor using the electronic address or communicating with a supplier of consumable using the electronic address".

Appellants argue that the limitation above is not inherent.

As discussed above, every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. In Beard, an electronic address must be used to send a request to re-order new modules through the network, in order to communicate with the manufacturer or service organization (col. 8, lines 29-34).

D. There is no motivation to combine the teachings of Himmel with the teachings of Beard in support of the rejection of claim 5.

Appellants argue that the motivation rationale provided by the office is insufficient and that the motivation relied upon by the Office is deficient, thus the Office has failed to meet their burden of establishing a proper *prima facie* 103 rejection.

In response to Appellants' argument that the motivation rationale by the Office is insufficient and that the motivation relied upon by the Office is deficient, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in Himmel col. 13, lines 40-41 to provide updated bookmarks (collection of URLs) in an easy and automatic way.

A motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the "improvement" is technology independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal and even common-sensical – there exists in

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these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skill rendering him capable of combining the prior art references. *Dystar* Fed Cir, 06-1088 2006 Furthermore, *KSR* forecloses Appellants' argument that a specific teaching is required for a finding of obviousness. *KSR*, 82 USPQ2d at 1396

Appellants argue that "Beard is void of any teaching to an electronic address".

The Examiner directs Appellants' attention to the discussion above.

E. There is no motivation to combine the teachings of Dent with the teachings of Beards in support of the 103 rejection of claims 2-3, 7, 9, 10, 16, and 20.

Appellants argue that "the Office has failed to set forth proper motivation to combine the reference teaching and the Office has failed to set forth a proper prima facie rejection for at least this reason".

In response to Appellants' argument that the Office has failed to set forth proper motivation to combine the reference teaching, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.

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Cir. 1992). In this case, the motivation is found in Dent col. 2, lines 40-41 to establish communications with a remotely located service provider via a network.

A motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the “improvement” is technology independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal and even common-sensical – there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skill rendering him capable of combining the prior art references. *Dystar Fed Cir*, 06-1088 2006 Furthermore, *KSR* forecloses Appellants’ argument that a specific teaching is required for a finding of obviousness. *KSR*, 82 USPQ2d at 1396

F. Limitations of claims 10 and 16 are not disclosed nor suggested by the prior art even if the teachings of Dent are combined with the teachings of Beard.

Appellants argue that “the teachings of Beard and Dent, taken alone or in combination, fails to disclose or suggest extraction of a universal resource locator for a vendor or supplier of consumables appropriate to a geographical area within which the engine is to be deployed”.

The Examiner does not agree. Beard was cited for teaching extraction of an electronic address for a vendor or supplier of consumable appropriate to a geographical area within which the engine is to be deployed. Beard discloses a printing apparatus comprising a distribution board, which can send or receive messages through the network (col. 6, lines 62-67). The distribution board interacts and is connected with memory devices called CRUMs (customer replace unit monitors), which are associated with one or more customer-replaceable modules within the apparatus and retain information for the particular module about how that module is being used within a machine (col. 7, lines 5-8; col. 7, lines 24-26; col. 7, lines 36-38). The CRUM is a small notepad on which certain key data is entered and retained and also periodically updated (col. 7, lines 26-28). The CRUM includes a non-volatile memory which is designed for special applications requiring data storage in a ROM, PROM, EEPROM mode (col. 7, lines 38-40). The CRUM serves as both a transmitter and receiver in the synchronous transfer of data with distribution board (col. 7, lines 44-46). Information such as codes is stored in the CRUM memory (col. 8, lines 14-15). The information includes a type of service plan code and market region code. One type of service plan code is a lease arrangement which it becomes the responsibility of the manufacturer or service organization to replace modules well in advance of any end-of-life of the module (col. 8, lines 20-24). The lease arrangement, which is symbolized by a particular service plan code in the CRUM, could instruct the distribution board to send a request to re-order new modules through the network to the manufacturer or service organization (col. 8, lines 29-34). Beard also discloses a market region code, which is placed by the

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manufacturer in a predetermined address in the CRUM memory, that identifies the module as belonging to a particular market region, such as a geographical region (col. 8, lines 44-47).

The Examiner notes that every computer has a unique address in order to communicate with other computers within a network. The unique address, which is a number or name, identifies the computer uniquely among all the computers on the network, in order for a computer to exchange data and files or send and receive messages with other computers on the network. A computer can only exchange data and files or send and receive messages to another computer if it knows that computer's address. In Beard, an electronic address must be used to send a request to re-order new modules through the network, in order to communicate with the manufacturer or service organization (col. 8, lines 29-34).

Such CRUM having certain key data which is entered and retained and also periodically updated; CRUM serving as both a transmitter and receiver in the synchronous transfer of data with distribution board; distribution board interacting and is connected to the CRUMs; information being stored in the CRUM memory; a particular service plan code in the CRUM, instructing the distribution board to send a request to re-order new modules through the network to the manufacturer or service organization; and the market region code, which is placed by the manufacturer in a predetermined address in the CRUM memory, that identifies the module as belonging to a particular market region, such as a geographical region are considered extraction of an electronic

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address for a vendor or supplier of consumable appropriate to a geographical area within which the engine is to be deployed.

The Examiner then turns to Dent to teach the universal resource locator (web address) (col. 4, line 18).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Marissa Thein

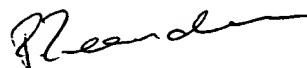


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